

### REMARKS

1. In response to the Office Action mailed June 16, 2006, Applicants respectfully request reconsideration. Claims 1-9 and 11-39 were last presented for examination. In the outstanding Office Action, claims 1-7, 11, 19 and 21-39 were rejected while claims 8, 9, 12-18 and 20 were previously withdrawn from consideration. By the foregoing Amendments, claims 3-7, 11, 19, 21, 23 and 28-31 have been amended. Claims 1, 2, 22, 24-27 and 33-39 have been cancelled, and claims 40-54 have been added. Thus, upon entry of this paper, claims 3-9, 11-21, 23, 28-32 and 40-54 will be pending in this application. Of these thirty-nine (39) claims, four (4) claims (claims 23, 40, 41 and 45) are independent. Based upon the above Amendments and following Remarks, Applicants respectfully request that all outstanding rejections be reconsidered, and that they be withdrawn.

#### *Amendments to the Specification*

2. Applicants thank Examiner for acknowledging that the Examiner has entered the Amendments to the Specification filed by Applicants on September 8, 2003.

#### *Claim Amendments*

3. By the foregoing Amendments, Applicants have amended the claims and respectfully submit that the above Amendments do not narrow the scope of the claims and that no new matter has been added.

4. New claims 40-54 have been added to further claim embodiments of the present invention. Applicants respectfully assert that no new matter has been added.

#### *Claim rejections*

5. Claims 1-7, 11, 19, and 21-39 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,788,711 to Lehner, *et al.* (hereinafter, "Lehner"), and in the alternative, as obvious under 35 U.S.C. 103(a) over Lehner in view of U.S. Patent No. 6,517,476 to Bedoya, *et al.*, (hereinafter, "Bedoya"). Applicants respectfully disagree.

#### *Lehner Fails to Teach or Suggest All Elements of Applicants' Claim 1*

6. In the Office Action dated June 6, 2006, (hereinafter, "the Office Action") the Examiner asserts that Lehner discloses "a releasable coupling unit disposed between the

transducer and the micromanipulator. The releasable coupling comprises a transducer-side coupling element and a micromanipulator-side coupling element... The Examiner considers the releasable coupling to be a snap-in coupling in that the transducer can be snapped into and removed from the coupling.” (See, Office Action, page 3.) Applicants assert that the Examiner’s assertions are unsupported by Lehner.

7. Lehner is directed to a permanently implantable positioning system for a hearing system. (See, Lehner, Abstract.) In Lehner, a positioning system is mounted in a recipient and a transducer may be attached to the positioning system so as to hold the transducer in place. (See, Lehner, col. 3, lines 1-17.) In most embodiments of Lehner, the transducer is fixedly attached to the positioning system and cannot be easily removed. (See, Lehner, col. 3, line 1- col. 5, line 63.) However, in one embodiment of Lehner, “[i]f mechanical decoupling or elastic bearing between positioning system and implantable means [transducer] fixed in receiver is necessary, an elastic or spring elastic intermediate piece can be inserted between the receiver and the implantable means.” (See, Lehner, col. 7, lines 25-31.) In other words, in most embodiments of Lehner, the transducer is simply inserted into a receiver, and the receiver locks the transducer therein. (See, Lehner, col. 3, line 1- col. 5, line 63.) In the one specific embodiment, an elastic piece is inserted around the inside edge of the receiver, and the transducer is inserted into this elastic rimmed receiver and is held therein.

8. In the Office Action, the Examiner asserts that, in Lehner, the “transducer-side coupling element is at least partially elastic.” (See, Office Action, page 3.) In support of this assertion, the Examiner points to the above recited portion of Lehner that teaches “an elastic or spring-elastic intermediate piece” inserted between the receiver and the transducer. (See, Lehner, col. 7, lines 29-31.) However, Applicants assert that this element fails to teach or suggest a “transducer-side coupling element” let alone “a transducer-side coupling element **connected to said transducer**” because there is absolutely no teaching in Lehner that would suggest that this elastic element is “connected” to the transducer. (emphasis added).

9. As noted above, in Lehner, the elastic piece is merely inserted between the receiver and the transducer and is not connected to either the transducer or the positioning means. (See, Lehner, col. 7, lines 29-31.) Lehner totally fails to demonstrate in any way that the elastic piece would be connected to any other element, let alone the transducer.

10. In reality, one of ordinary skill in the art would likely conclude that the elastic element of Lehner is, if connected to any element at all, would be connected to the receiver. (*See*, Lehner, col. 7, lines 25-37.) This is a reasonable interpretation of Lehner because all other teachings of Lehner disclose a system in which a transducer is directly inserted into a receiver, and is held therein by the receiver. (*See*, Lehner, col. 3, line 1- col. 5, line 60 For example, in Lehner, “[a]ccording to one especially preferred embodiment [of] the positioning system according to the invention is ... a receiver located on the carriage for the implantable means to be positioned.” (*See*, Lehner, col. 3, line 66- col. 4, ln. 16.) Further stated, “[c]arriage has a receiver into which the desired means can be inserted without play.” (*See*, Lehner, col. 7, lines 25-26.) These teachings of Lehner appear to disclose a system wherein a transducer is placed directly into a receiver: either a rigid annular receiver, or a rigid annular receiver having an elastic piece mounted thereon. (*See*, Lehner, col. 3, lines 10-17; col. 7, lines 25-37.) Due to these apparent teachings of Lehner, Applicants assert that the Examiner is improperly interpreting Lehner, and that Lehner completely fails to teach or suggest a “transducer-side coupling element” let alone a “transducer-side coupling element connected to said transducer” as recited in Applicants’ claim 1.

11. Second, not only does Lehner fail to teach or suggest a “transducer-side coupling element,” Lehner further fails to teach or suggest “wherein said transducer-side coupling element releasably snaps into said micromanipulator-side coupling element, and is mechanically locked therein” as recited in Applicants’, claim 1. As noted above, in Lehner it appears that the elastic or spring elastic piece is an element of the receiver and that the transducer is inserted in the elastic rimmed receiver. (*See*, Lehner, col. 7, lines 25-31.) The transducer is directly held in the receiver. Therefore, because of this direct insertion of the transducer into the receiver, that the receiver’s direct engagement with the transducer, Lehner does not teach or suggest a “wherein said transducer-side coupling element releasably snaps into said micromanipulator-side coupling element” or wherein the transducer-side coupling element is “mechanically locked” into said micromanipulator-side coupling element.

12. Therefore, for at least the reasons discussed above, Applicants assert that Lehner fails to teach or suggest all elements of Applicants’ claim 1. As a result, Applicants respectfully request that the rejection of claim 1, as anticipated by Lehner, be reconsidered, and that it be withdrawn.

***Lehner Fails to Teach or Suggest All Elements of Applicants' Claims 23 and 40***

13. Furthermore, Applicants submit that for at least the reasons discussed above with reference to claim 1, Lehner also fails to teach or suggest all elements of Applicants' claims 23 and 40. Therefore, Applicants respectfully assert that claims 23 and 40 are patentable over Lehner.

***Lehner Fails to Teach or Suggest All Elements of Applicants' Claim 45***

14. Applicants further assert that Lehner fails to teach or suggest all elements of Applicants' claim 45. As noted above, Lehner is directed to a device wherein a transducer is directly inserted into a receiver. (*See*, Lehner, col. 3, line 1- col. 5, line 63.) Mechanical decoupling of the transducer from the receiver is accomplished by inserting an elastic piece between the transducer and the receiver. (*See*, Lehner, col. 7, lines 25-31.)

15. First, for the same reasons as discussed above with reference to claim 1, Applicants assert that Lehner fails to teach or suggest a "transducer-side coupling element, connected to said transducer" as recited in Applicants' claim 45.

16. Second, even if the Examiner was to incorrectly interpret the elastic piece of Lehner as a "transducer-side coupling element," Lehner would still fail to teach or suggest all elements of Applicants' claim 45. Lehner completely lacks a "transducer-side coupling element...having a first configuration and an at least partially deformed second configuration...wherein said transducer-side coupling element ***adopts said second configuration during insertion into said micromanipulator-side element, and regains said first configuration following insertion***" as recited in Applicants' claim 45. (emphasis added). In the device of Lehner, incorporating an elastic piece between the transducer and the positioning means, the elastic piece would be placed into a deformed configuration upon coupling of the transducer to the positioning means. (*See*, Lehner, col. 7, lines 25-31; FIG. 1.) Furthermore, as shown in Figure 1, the elastic piece is held in this deformed configuration for as long as the transducer is coupled to the positioning means. Therefore, because the elastic piece of Lehner adopts, and maintains a deformed configuration rather than "adopts said second configuration during insertion into said micromanipulator-side

element, and regains said first configuration following insertion,” Lehner fails to teach or suggest all elements of Applicants’ claim 45.

17. Furthermore, because Lehner fails to teach or suggest a device that “regains said first configuration following assertion,” Lehner inherently fails to teach a device that “regains said first configuration following insertion, to thereby mechanically lock said transducer-side coupling element into said micromanipulator-side coupling element” as recited in Applicants’ claim 45.

18. For at least the reasons discussed above, Applicants respectfully assert that Lehner completely fails to teach or suggest all elements of Applicants’ claim 45, and that claim 45 is patentable over Lehner.

***The Combination Suggested by the Examiner is Prima Facie Improper***

19. As noted above, the Examiner asserts that the combination of Lehner and Bedoya teaches all elements of Applicants’ claim 1. However, as recited in Applicants’ prior remarks to the Office Action dated October 4, 2005, (hereinafter, “prior remarks”), this combination is prima facie improper and should be withdrawn.

20. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings* (emphasis added) . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art and not based on Applicants’ disclosure* (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

21. In the previous Office Action dated October 10, 2004 (hereinafter, “the previous Office Action”) the Examiner asserted that “[i]t would have been obvious to modify the releasable coupling unit as disclosed by Lehner et al. to include a snap-in configuration as taught by Bedoya et al. in order to *facilitate sealable interconnection... and selective interconnection* ...between the micromanipulator and the transducer. (See, Office Action, page 3, emphasis added.) In the most recent Office Action, the Examiner has changed this motivation and now asserts that one would “it would have been obvious to modify the releasable coupling unit as disclosed by Lehner et al. to include a snap-in configuration as

taught by Bedoya et al in order to provide a coupling which provides *a tight, snug fit between components and facilitates in situ selective interconnection.*" (See, Office Action, page 3, emphasis added.) However, this new motivation asserted by the Examiner is insufficient to explain why one would have been motivated to make the proposed combination.

22. As held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."); Also see, *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.")).

23. As recited by Applicants in the prior remarks, Bedoya teaches a connector to provide electrical connection between implantable components of a system. (See, Bedoya, col. 5, lns. 25-49.) Due to the electrical connection capabilities of Bedoya, it is important to protect this connection by making a tight connection between components that is capable of sealing out fluids and other harmful materials. Furthermore, Bedoya discloses a system that "provides for selective interconnection between two or more implantable components." (See, Bedoya, Abstract.)

24. However, as noted above, Lehner is directed to a system wherein a "carriage has a receiver into which the desired implantable means [transducer] can be inserted without play. If mechanical decoupling or elastic bearing between positioning system and implantable means fixed in receiver is necessary, an elastic or spring-elastic intermediate piece can be inserted between the receiver and the implantable means." (See, Lehner, col. 7, lns. 25-31.) Similarly, in Lehner the transducer is tightly held in the receiver and can only be removed with the application of mechanical force. (See, Lehner, col. 7, lns. 25-31.) In other words, Lehner teaches that mechanical decoupling, ie. detachment or interconnection, and snug connection, is possible simply by inserting an elastic or spring-elastic intermediate piece between the receiver and the transducer. This capability of Lehner is certainly a type of "in situ elective interconnection" that "provides a tight, snug fit between components." Therefore, the reasoning that one would be motivated to incorporate the alleged connection

of Bedoya into Lehner to provide a “tight, snug fit” or to provide “in situ selective connection” is entirely misplaced.

25. Therefore, because Lehner already discloses a means for “tight, snug fit” and “selective interconnection,” there is no reason to incorporate the alleged snap-in connector of Bedoya to accomplish these purposes. Therefore, Applicants submit that the motivation provided by the Examiner would not have motivated one of ordinary skill in the art to make the combination suggested by the Examiner.

26. For the above reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* rejection under 35 U.S.C. §103, and for at least this reason the rejection of claim 1 should be withdrawn.

***The Proposed Combination Still Does not Contain  
All Elements of Applicants’ Claims***

27. As asserted by Applicants in the prior remarks, even if the references were modified in the manner proposed by the Examiner, the resulting combination would still fail to contain all elements of the claimed invention because Bedoya also fails to teach or suggest a “snap-in coupling. As set forth in the MPEP at §2142 “to establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all of the claim limitations.”

28. As noted above, Bedoya teaches a connector to provide electrical connection between implantable components of a system “that is configured for snap-in sealable engagement with an internal surface defined within an external housing.” (*See*, Bedoya, col. 5, Ins. 25-49; col. 8, 56-65.) In Bedoya, the alleged coupling unit comprises male and female connectors that slide together and which are mechanically locked together by mechanisms inside the male connector. (*See*, Bedoya, col. 5, Ins. 25-49; col. 8, 56-65.) However, there is no indication in Bedoya that this connector is a coupling unit “configured to permit removal of said transducer while maintaining the position of said micromanipulator” as recited in Applicants’ claim 1. There is no indication that either one of the connected elements of Bedoya retain its position once the male connector is removed from the system. As a result, this snap-in connector disclosed in Bedoya differs from the coupling unit as recited in Applicants’ claim 1.

29. Therefore, for at least the reason that neither Lehner or Bedoya teach the coupling as claimed in Applicants' claim 1, Applicants' assert that the rejection of claim 1 under §103 was improper and should be withdrawn.

30. Applicants further submit that for the reasons discussed above, Applicants' claimed invention, as recited in claims 23 and 40, are not obvious in view of the art of record. Therefore, Applicants assert that claims 23 and 40 are patentable over the art of record.

31. Applicants also submit that Bedoya fails to teach or suggest a device "wherein said transducer-side coupling element adopts said second configuration during insertion into said micromanipulator-side element, and regains said first configuration following insertion, to thereby mechanically lock said transducer-side coupling element into said micromanipulator-side coupling element" as recited in Applicants' claim 45. Therefore, for at least this reason, Applicants assert that the combination of Lehner and Bedoya does not render Applicants' claim 45 obvious.

***Dependent claims***

32. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

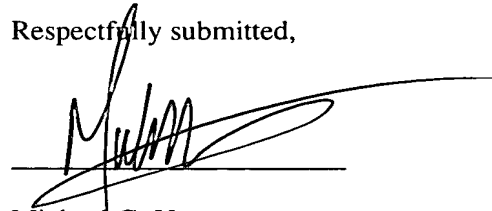
***Conclusion***

33. In view of the foregoing, this application should be in condition for allowance. A notice to his effect is respectfully requested.



34. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application, cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael G. Verga', is written over a horizontal line. The signature is stylized with a large, sweeping 'M' and 'V'.

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